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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/120,105	09/10/1993	ANDREAS WINTER	HOE92F294	1612

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EXAMINER

WILSON, DONALD R

ART UNIT PAPER NUMBER

1713

DATE MAILED: 03/29/2002

35

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

08/120,105

Applicant(s)

WINTER ET AL.

Examiner

D. R. Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15,17-19,21,25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,17-19,21,25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 2/11/02, has been fully considered with the following results.
2. The amendment overcomes the previous objection to new matter and the corresponding rejection of claims under 35 U.S.C. § 112, first paragraph, and the objection and rejection are withdrawn. Upon reconsideration the Examiner accepts that one of ordinary skill in the art would readily envisage from the disclosure compositions of homo or co-polymers of propylene with 97.5 to 100 wt.% propylene units.
3. The amendment is not deemed to be persuasive in overcoming the rejection of Claims 15, 17-19, 21-25 and 27-31 under 35 U.S.C. 112, first paragraph, concerning the DSC characterization of the melting behavior of components of the blend, as well as that of the blend itself, and the rejection is maintained as is discussed below.
4. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, concerning, the definitions of  $R^a$ ,  $R^b$ ,  $R^{11}$  and  $R^{12}$ , and in regards to which peak of the DSC spectrum "the melting peak" refers, and in these regards the rejection is withdrawn. However, the rejection on the other bases are maintained as is discussed below. Further, the amendment to overcome the indefiniteness of the melting peak introduces new matter and indefiniteness as is discussed below.
5. Applicant's willingness to file a terminal disclaimer to overcome the obviousness double patenting is acknowledged.

### ***Previously Cited Statutes***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Objection to New Matter***

7. The amendment filed 2/11/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

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Applicant has amended Claim 17 to recite "--- the half-intensity width of the melting maximum ---" as opposed to "--- the half-intensity width of the melting peak ---", and similarly "--- quarter maximum height---" as opposed to "--- quarter peak height---". The basis in the specification is for the peak, not the maximum, and the amended language leaves in doubt what is meant, i.e., is this the width of the peak or the melting point range. Applicant argues in the amendment that this is the [total] width of the curve. However, this is not consistent with the language at page 2, lines 17-25, of the specification.

8. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112, First Paragraph***

9. ***Claims 15, 17-19, 21-25 and 27-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.*** Applicant depends on DSC characterization of the melting behavior of components of the blend, as well as that of the blend itself, in regards to both melting peak and width of the melting point endotherm. The crystallinity of both the components and the blend would be expected to be a function of the thermal history of the materials, yet the specification provides no data on thermal conditioning of the samples prior to measurement. (See for example the discussion in EP'189 regarding thermal fusion data as a function of thermal history). The basis of this rejection was stated in Detailed Action § 5(b) of the Office Action of 4/3/00 and has been further discussed in Detailed Action § 13 of the Office Action of 3/6/01 and Detailed Action § 13 of the previous Office Action. Applicant repeats previous arguments which are not deemed to be persuasive for reasons of record. Applicant is relying on the melting behavior of the composition to define the invention being claimed and it is not seen that applicant has defined in a "full, clear, concise, and/or exact" manner the melting behavior as is required under 35 U.S.C. § 112, first paragraph.

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**35 U.S.C. § 112, Second Paragraph, Rejection**

10. **Claims 15, 17-19, 21-25 and 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

11. The language of Claim 17 is indefinite because:

a. As has been discussed above “--- the half-intensity width of the melting maximum ---” and similarly, “--- quarter maximum height---” are indefinite because it is unclear what is meant, e.g., is this the width of the peak or the melting point range. Applicant's argument that it is the height of the [total] width of the curve is not deemed to be persuasive as this is inconsistent with the language of the specification as noted above.

b. The amendment left the fragment of a phrase “or R<sup>a</sup> and R<sup>b</sup>” in line 9, which makes no sense. Presumably applicant intended to delete this fragment.

12. The definition of R<sup>3</sup> and R<sup>4</sup> “--- where the substituents ---- form together with the atoms connecting them a ring” is indefinite, because it can't be told which atoms are connected together. The basis of this rejection was stated in Detailed Action § 6(a)(vi) of the Office Action of 4/3/00, in Detailed Action § 15(d) of the Office Action of 3/6/01, and in Detailed Action § 16 of the previous Office Action. Applicant has not further traversed the basis of the rejection which is therefore maintained for reasons of record.

**Rejection Under 35 USC § 112, Fourth Paragraph**

13. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

14. New Claim 32 is rejected under 35 U.S.C. 112, fourth paragraph, for not further specifying a limitation of the subject matter in the parent claim(s). It is not seen that Claim 32 further limits the process of Claim 17 as the composition produced in claim 17 is already characterized by a broad melting range.

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***Obviousness Double Patenting***

15. **Claims 15, 17-19, 21-25 and 27-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,700,886 (Winter'886).** The basis of this rejection was stated in Detailed Action § 11 of the Office Action of 4/23/00 and has been further discussed in Detailed Action § 18 of the Office Action of 3/6/01. Applicant's has stated a willingness to file a terminal disclaimer when the other rejections are withdrawn. However, as a disclaimer has not been received the rejection is maintained.

***Action Is Final***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

D. R. Wilson  
Primary Examiner  
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